

## **REMARKS**

### **I. Status of the Claims of Patent Application**

In the present Amendment, new independent claims 67 and 68 are added to the patent application. In addition, claim 14 is amended to be in independent form by incorporating features of claims 1 and 9. Claims 19 and 20 are also amended to remove inadvertent typographical errors. In total, there are presently 21 claims pending in the application comprising claims 1-2, 4-20, 67, and 68. Of these claims, six are presented for consideration in independent form. Applicant acknowledges that the amendment to claim 18 submitted in the previous action was inadvertently identified in the previous reply to be in the category of "original" claims.

### **II. Summary of the Office Action**

In the present Office Action, the specification of the patent application is objected to "as failing to provide proper antecedent basis for the claimed subject matter." Office Action, at page 2. In addition, claims 1, 17, 19, and 20 are rejected for including a term that has "insufficient antecedent basis . . . in the claim." Id. Claims 1-2, 4-11, and 16-20 are rejected "under 35 U.S.C. §103(a) as being unpatentable over Jiang (hereinafter 'Jiang', 6,167,432) in view of Aras et al (hereinafter 'Aras', 5,867,653)." Id. at page 3. Claims 12-13, 15 are rejected "under 35 U.S.C. §103(a) as being unpatentable over Jiang in view of Aras and further in view of Sammon et al. (hereinafter 'Sammon', 6,563,914)." Id. at page 10. Finally, claim 14 is rejected "under 35 U.S.C. §103(a) as being unpatentable over Jiang in view of Aras and Sammon and further in view of Pinard et al (hereinafter 'Pinard', 5,940,834)." Id. at page 11.

### **III. Request for Reconsideration**

Applicant requests reconsideration of the objection and rejections in the Office Action and further requests allowance of the application on the basis of the amendments and remarks presented herein.

#### **IV. Obviousness Rejections are Contrary to the Teachings of the Cited Art**

The rejections issued in the Office Action under 35 U.S.C. §103 are not sufficient to establish obviousness by a preponderance of the evidence. The primary patent relied on for each rejection teaches away from the modifications proposed in the Office Action.

##### **A. Claims 1-2, 4-11, and 16-20 are not Obvious in view of Jiang and Aras**

###### *1. Jiang Teaches Away From the Proposed Combination*

In the Office Action, claims 1-2, 4-11, and 16-20 are rejected as being obvious in view of the combination of Jiang and Aras. Claims 1-2, 4-11, and 16-20 are not obvious in view of the combination of Jiang and Aras at least because Jiang teaches away from such a combination.

Claims 1, 17, 19, and 20, which are directed to systems and methods for providing a collaborative workspace for sharing data include, among other things, features directed towards the sharing of the data through a dedicated site. Jiang is directed towards and describes peer-to-peer conferencing techniques over the Internet and as such, because of its peer-to-peer approach does not show the sharing of conference data through a dedicated site. The substance of the Office Action concedes this matter. The Office Action states "Jiang fails to disclose such centralization with all shared communication from one participant to another passing through a central location." To alleviate this deficiency in Jiang, the Office Action relies on Aras and proposes to modify the techniques described in Jiang with "Aras's centralized system." Office Action, at page 4. As motivation for the proposed combination, the Office Action states "it would be advantageous and simplified not to have a peer-to-peer system as in Jiang as this would allow the central server to perform special and enhanced functions on the communication between participants." Office Action, pages 4-5. Such a combination and the supporting motivation for the combination, however, are contrary to the explicit teachings of Jiang.

For example, in connection with FIG. 2, Jiang states:

In this peer-to-peer paradigm, there is no host server, and a number of clients 18a-18e are connected via a number of channels 20a-20e in a variety of manners. The advantage with this paradigm is that there is not a central host server to connect the clients. As long

as the clients utilize application programs allowing communication across networks between the clients, this network paradigm is feasible and desirable." Jiang, column 1, lines 22-41 (emphasis added).

The above quoted section clearly teaches away from the use of a central host server in favor of a peer-to-peer implementation. Moreover, the Summary of the Invention in Jiang states:

"a method for facilitating the creation and maintenance of network connections over an interconnected network for the purpose of facilitating the creation and participation of on-line conferences in accordance to the peer-to-peer paradigm is disclosed. . . . Once the conference is established, no data goes through the designated site or a central host. Data packets are directly sent to and received by the respective application program of each participant. . . . Another advantage of the present invention is that the established conference has no data going through a central host or a designated site." Jiang, column 2, lines 19-44 (emphasis added).

As such, Jiang further emphasizes that a central host or designated site is undesirable for conferencing participants. In addition, Jiang states that:

"A user, by using a web-browser and a helper-application program, may go to the virtual conference hall . . . . The host machine supporting the virtual conference hall does not actually host any conferences." Jiang, column 3, lines 1-7.

"Once the conference session is established, there is no traffic (data packets) going through the conference hall server machine (the host computer). The conference participants communicate directly to each other via their helper-applications." Jiang, column 5, lines 54-58 (emphasis added).

Therefore, contrary to the above-quoted assertion of the examiner, Jiang explicitly teaches that it would be advantageous and preferred to have a peer-to-peer system, and teaches that to implement the Jiang system, communications between participants should not be routed through a central server. As such, Jiang limits its disclosure and systems and methods for conferencing described therein to peer-to-peer

interconnections and as such, limits modifications to such systems and methods to be peer-to-peer.

2. *The Proposed Modification is Directly Contrary to Jiang*

The teachings in Jiang are directly contrary to the proposed modification in the Office Action. Jiang explicitly teaches, as quoted above, that once a conference is underway using peer-to-peer communications there no data routed through the host. The modification suggested in the Office Action proposes to modify conferences that are underway using peer-to-peer communications to incorporate centralization by using the host to share data. This proposed modification is directly contrary to the preference explicitly stated in Jiang that no data goes through a central host or designated site once a conference is established.

The Office Action states that Figure 7 of Jiang shows a "dedicated site:" "Figure 7 discloses the dedicated website that is created defining the workspace to enable other participants to join into." Office Action, at page 12. Figure 7 of Jiang is titled "Conference Registration" and is one component of the systems and methods that are described in Jiang to use a host server. The description of those components in Jiang are limited to registering, creating, or joining a peer-to-peer interconnected conference, in which the conference is created and is operated to the exclusion of the host server. In Jiang, once a user selects to join a conference by interacting with the website of FIG. 7, an on-going peer-to-peer conference is joined by the user which is separately implemented from FIG. 7. The data shared in such conferencing cannot be shared through FIG. 7 of Jiang because conference communications are explained by Jiang to occur only through peer-to-peer connections in specific avoidance of any host server that may have displayed FIG. 7. To propose to modify the conferencing of Jiang using Aras to "not have a peer-to-peer system" is directly contrary with the teachings of Jiang.<sup>1</sup> Thus, Jiang clearly teaches away from modifying its peer-to-peer system to include "centralized features" as proposed by the examiner.

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<sup>1</sup> Applicant is merely reiterating the interpretation followed in the Office Action to clarify its position. Such statements are not to be understood to mean that applicant is accepting or agreeing with such interpretation. Applicant's statements are not presented to provide comment in that respect.

3. *The Case Law is Consistent with Applicant's Remarks*

"It is improper to combine references where the references teach away from their combination." In re Grasselli, 713 F.2d 731, 643, 218 USPQ 769, 779 (Fed. Cir. 1983)." See MPEP 2145, page 2100-157. "We have noted ..., as 'a useful general rule,' that references that teach away cannot serve to create a prima facie case of obviousness." McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 USPQ2d 1001 (Fed. Cir. 2001) (quoting In re Gurley, 27 F.3d 551, 31 USPQ2d 1130 (Fed. Cir. 1994)). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant ... [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." In re Gurley, 27 F.3d 551, 31 USPQ2d 1130 (Fed. Cir. 1994).

In addition, the above-quoted section of Jiang cannot be ignored in the examination of the application. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would teach away from the claimed invention." W.L. Gore & Assocs., Inc., v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)." See MPEP 2141.03, page 2100-122. "[It] is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 353 F.2d 238, 147 USPQ 391 (CCPA 1965). "A reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered." Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

In this case, Jiang clearly states in a number of ways that "no data goes through the designated site or a central host," which is directly contrary to the modification proposed in the Office Action to route data through the designated site or central host." As such, claims 1, 17, 19, and 20 are not obvious in view of the combination of Jiang and Aras at least because Jiang teaches away from such a combination. Claims 2, 4-11, 16, and 18, which depend from either base claim 1 or 17, are also not obvious at least for the reasons provided herein for the non-obviousness of claims 1 and 16 in view of Jiang and Aras.

**B. Claims 12, 13, and 15 are not Obvious in view of Jiang, Aras, and Sammon**

In the Office Action, claims 12, 13, and 15 are rejected as being obvious in view of the combination of Jiang, Aras, and Sammon. Claims 12, 13, and 15, which depend from base claim 1, are not obvious at least for the reasons provided herein for the non-obviousness of claim 1 in view of Jiang and Aras.

**C. Claim 14 is not Obvious in view of Jiang, Aras, Sammon, and Pinard**

In the Office Action, claim 14 is rejected as being obvious in view of the combination of Jiang, Aras, Sammon, and Pinard. In order to further the prosecution the patent application Claim 14 has been amended to be in independent form and to include all the features of claims 1 and 9 from which it previously depended. Accordingly, claim 14, is not obvious at least for the reasons provided herein for the non-obviousness of claim 1 in view of Jiang and Aras. In addition, claim 14 recites that the "calendar and event planner include a list of tasks," which is not shown or suggested by the Pinard as relied on by the examiner. Moreover, Pinard teaches the use of a web page or server which is again contrary to the direct teachings of Jiang. Accordingly, claim 14 is not obvious in view of the combination of Jiang, Aras, Sammon, and Pinard.

**D. Other Remarks**

As in the previous Amendment filed on February 26, 2004, applicant maintains that Jiang does not show or suggest: (1) a transmitter for sending information about the existence of a dedicated site to secondary users that is nominated by the primary user ("Transmitter Feature") and (2) sharing of data in a collaborative workspace in accordance with a hierarchy ("Hierarchy Feature"). Furthermore, the absence of such features from Jiang is not alleviated by its combination with Aras. Accordingly, claims 1, 17, 19, and 20, which include features directed towards the Transmitter Feature and the Hierarchy Feature are also allowable because such features are not show or suggested by the combination of Jiang and Aras.

**E. Summary**

Accordingly claims 1, 2, and 4-20 are not obvious in view of the cited patents are relied on the Office action. Reconsideration and allowance of claims 1, 2, and 4-20 are requested.

**V. Specification Provides Antecedent Basis for Claimed Subject Matter**

In the Office Action, the "specification is objected to as failing to provide proper antecedent basis for the claimed subject matter." Office Action, at page 2. The Office Action states that:

"Correction of the following is required: 'Sharing data' and/or 'shared data' being shared with the primary and secondary users and the terminology thereof is not explicitly disclosed in the specification, it is requested, applicant specifically reference such limitations in the specification and drawings in next reply." Office Action, at page 2.

The Office Action cites to 37 CFR 1.75 (d)(1) and MPEP §608.01(o) in support of the objection. Section 608.01(o) states that "[t]he meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import." Subsection (d)(1) of 37 CFR 1.75 states that "[t]he claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description."

In this case the examiner is objecting to "sharing data" and/or "shared data." Such language is supported by the specification of the application. For example, the following quotes from the specification provide this support:

"Recently, the need for collaborative computing environments has been receiving increasing attention. People are finding that it is more and more important to share information and work together to meet common goals. With increasing specialization in the marketplace, there is frequent need to work together with people from different offices, different organizations and even different countries to satisfy the requirements of a particular project or goal. Managing collaborative initiatives of this type is not a simple matter." Page 1, lines 10-16. (emphasis added)

"Once connected to dedicated site 25 created on server 10, primary user 30 and secondary user 40 both have access to at least some of the information stored at the site, the ability to

access and process at least some of the information and the ability to input and store processed and/or new information." Page 5, lines 24-27. (emphasis added) See also FIG. 1.

"Server 10 may be provided a number of general sites (e.g., Sites #1, #2, #3) which are automatically accessible to primary user 30 and secondary user 40; other sites (e.g., Site #6) which are accessible to only one of the users; and some sites (e.g., Site #7) which can only be accessed by a system administrator (not shown)." Page 6, lines 3-6. (emphasis added)

"Thus, an advantage of the present system is that . . . the user and his/her team members can access applications software without the need for each team member to have individual copies of each applications software." Page 6, lines 26-29. (emphasis added)

"[A] basic form of security is to provide the dedicated site created with a password which must be entered by both the primary user and the secondary users to gain access to the workgroup. . . . Providing each secondary user with a unique password also permits primary user to set up different levels of information which can be accessed within the workgroup by each secondary user, i.e., the workgroup can be created on a "need to know" basis." Page 9, lines 6-12. (emphasis added)

As such the above-quoted examples from the specification provide clear support for "sharing data" and/or "shared data."

In the objection, the examiner appears to require literal support (for those terms in the specification. This, however, is contrary to the above-quoted section of the MPEP which states that "[t]he meaning of every term used in any of the claims should be apparent from the specification," (emphasis added) and is also contrary to the above-quoted section of the CFR which states that "the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." (emphasis added). As such, reconsideration and withdrawal of the objection are respectfully requested.

#### **VI. Sufficient Antecedent Basis for "Said Shared Data" Exists in Claims**

In the Office Action, claims 1, 17, 19, and 20 are rejected under 35 U.S.C. §112. The Office Action states that there is insufficient antecedent basis for "said shared data" in the claims. In this context, the MPEP states that:



"the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite." MPEP §2173.05(o)

The claims in question initially recite "providing a collaborative workspace for sharing data," which is followed by referring to that data using the term "said shared data." Those of ordinary skill in the art can reasonably ascertain the connection and meaning of this usage, and as such, would also be able to ascertain the scope of the claims. This conclusion is further evidenced by the fact that the attendees of the examiner interview of February 24, 2004 indicated that they understood the scope of such terms when the term was proposed during the interview, and further, agreed to such an amendment. Reconsideration and withdrawal of the rejection is respectfully requested.

#### **VII. New Claims are Allowable**

In order to further the prosecution of the application and to avoid piecemeal prosecution of the patent application, applicant presents new claims 67 and 68, which in combination with the other independent claims provide a range of claim scope in independent form. Claims 67 and 68 are at least allowable for the same reasons as provided herein for the allowability of claim 1. Consideration of claims 67 and 68 are respectfully requested.

### **VIII. Conclusion**

For the foregoing reasons, applicant submits that all of the claims are patentable over the cited art and respectfully requests reconsideration and an early indication of allowance. The Examiner is invited to contact the undersigned if any additional information is required.

Respectfully submitted,

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